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EXAMINER

MENDOZA JR, JORGE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/675,436	Applicant(s) KARAOGUZ ET AL.	
	Examiner JORGE MENDOZA JR	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims **1-37** are presented for Examination.
2. Claims **19 & 28** have been amended.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/24/2008 has been entered.

Response to Arguments

4. Applicant's arguments filed 05/09/2008 have been fully considered but they are not persuasive.
5. Applicant argues that the rejection relying on **Goldman (US PGPUB 2002/0112239 A1)** does not anticipate Claims **1-37** and fails to meet the claimed "*determining, at the first location, whether the associated set of pre-defined characteristics [associated with the requested media] matches the at least one parameter [related to monitoring media consumption activity of the user at the first location]; sending notification of the media request to a second location, via a communication network, if the determining results in*

a match; and refraining from sending a notification of the media request to the second location, via the communication network, if the determining does not result in a match," as recited in Claim 1.

The Examiner respectfully disagrees with Applicant's arguments. The Goldman reference has been relied upon to teach the selective gathering of viewer behavior information from a plurality of viewers - whereby the operator of a clearinghouse 80 is able to define the type & volume of viewer behavior information (i.e. when the user tunes to or requests to view or record particular programming) (§ [0022]) that is desired to be tracked - thereby controlling whether or not notification of viewer behavior gets sent to it in a real time manner (§ [0035]-[0037] & [0039]). Specifically, Goldman teaches (§ [0022]) the requesting of media by a viewer a first location- whereby the media request is when the user tunes to a television program via a set top box (§ [0022] & [0060]). Additionally, Goldman teaches that a clearinghouse 80 is able to dictate to a home entertainment system which information is to be sent to it, thereby allowing the home entertainment system to determine which information is to be sent out and which information is not- by way of matching EPG information with information requested by the clearinghouse 80 (§ [0036] & [0037]).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims **1-37** are rejected under 35 U.S.C. 102(e) as being anticipated by **Goldman (US PG Pub 2002/0112239)**.

With respect to Claim **1**, the claimed “*establishing at a first location, from a second location, at least one parameter related to monitoring media consumption activity of a user at a first location*” is met by Goldman that teaches the requesting of specific viewer behavior information **98**, containing type & volume of data pertaining to media consumption activity, from a user at a 1st location (home entertainment system **90**) by a clearinghouse system **100**, at a 2nd location (*Figs. 1-3; paragraph [0037]*). The claimed “*receiving, at the first location, a media request from the user, the requested media having an associated set of pre-defined characteristics*” is met by Goldman that teaches the tracking of viewer behavior information related to user at 1st location, **90**, making a request for media, whereby the identification of the requested media is made possible by information contained within an EPG (*paragraph [0032-0034]*).

The claimed “*determining, at the first location, whether the associated set of pre-defined characteristics matches the at least one parameter*” is met by Goldman that

teaches a home entertainment system, **90**, matching specific data requested by the clearinghouse system **100** with that of the data of the program being tracked (*paragraphs [0037-0036]*). The claimed “*sending notification of the media request to a second location, via a communication network, if the determining results in a match; and refraining from sending a notification of the media request to the second location, via the communication network, if the determining does not result in a match*” is met by Goldman that teaches the transmission of only select viewer behavior information **98**, from 1st location, home entertainment system **90**, to a 2nd location, clearinghouse system **100** (*Figure 2; paragraphs [0037] & [0043]*).

With respect to Claim **2**, the claimed “*wherein the first location is associated with one or more of an Internet protocol (IP) address, a media access control (MAC) address, and/or an electronic serial number (ESN)*” is met by Goldman that teaches Claim **1** and the use of an addressable set-top box, within home entertainment system **90**, that sends select viewer behavior information using the Internet (*paragraph [0010] & [0040]*). The claimed “Internet protocol (IP) address” is not explicitly taught by the Goldman reference. The Examiner furthermore notes that the use of IP addresses is necessary to selectively address and direct data among set-top boxes exchanging data on an Internet network.

With respect to Claim **3**, the claimed “*wherein the communication network comprises one or more of a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, and/or a wireless infrastructure*” is met by Goldman

that teaches Claim **1** in which the communication network **110** can include a cable, optical, terrestrial antenna system, satellite system etc. (*Fig1; paragraph [0029]*).

With respect to Claim **4**, the claimed “*wherein the communication network is the Internet*” is met by Goldman that teaches the use of an Internet connection by a user at the 1st location, home entertainment system **90**, in sending pertinent viewer behavior information **98** (*Fig. 1; paragraphs [0040] & [0060]*).

With respect to Claim **5**, the claimed “*wherein the media comprises one or more of audio, a still image, video, real time video, and data*” is met by Goldman that teaches video data corresponding to broadcast **88** being delivered to a 1st user at home entertainment system **90** (*Fig. 1; paragraphs [0029] & [0035]*).

With respect to Claim **6**, the claimed “*wherein consumption comprises one or more of playing audio, displaying a still image, displaying video, and/or displaying data*” is met by Goldman that teaches the use of a display device **92** at a 1st location (home entertainment system **90**) for the displaying of broadcast programming, such as video data (*Fig. 1 & 2; paragraphs [0022], [0027], [0031], & [0035]*).

With respect to Claim **7**, the claimed “*wherein the at least one parameter comprises a title keyword, a subject keyword, a time period, a genre, an artist, a media channel type, a mode, a language, information identifying the user, information indicating whether the user may be contacted, and information indicating how information related to the media request may be used*” is met by Goldman that teaches a central clearinghouse **100** indicating specific viewer behavior information that it desired to be

tracked, such as: channel ID, subscriber ID, program ID & title, city & state of channel, and the current date & time (*paragraph [0037]*).

With respect to Claim **8**, the claimed “*wherein the associated set of pre-defined characteristics comprises one or more of a title keyword, a subject keyword, a time period, a genre, an artist, a media channel type, a mode, and/or a language*” is met by Goldman that teaches the use of an EPG in making available data for viewer behavior information **98**, the data pertaining to: provider of broadcast, type of broadcast, date & time of broadcast, origination of broadcast, manner in which broadcast is being supplied, title of program, episode, director of program, actors, program ratings, etc. (*paragraph [0034]*).

Claim **9** is met as previously discussed with respect to Claim **1**. In addition, with respect to the claimed “creating at least one record of the media request, at the second location; and sharing information derived from the at least one record with a third party” is met by Goldman teaching the use of a storage device **104** for the gathering of viewer behavior information **98** at the clearinghouse system **100**, the creation of a viewer behavior information report **109**, and the transmittal of **109** to a third party, signal source **80** (*Fig. 3; paragraphs [0043] & [0048]*).

Claim **10** is met as previously discussed with respect to Claim **2**.

Claim **11** is met as previously discussed with respect to Claim **3**.

Claim **12** is met as previously discussed with respect to Claim **4**.

Claim **13** is met as previously discussed with respect to Claim **5**.

Claim **14** is met as previously discussed with respect to Claim **6**.

Claim **15** is met as previously discussed with respect to Claim **7**.

Claim **16** is met as previously discussed with respect to Claim **8**.

With respect to Claim **17**, the claimed "*wherein the third party is at least one of a third party media provider, a third party service provider, and a third party sales provider*" is met by Goldman that teaches the method of Claim **9** and the transmittal of a viewer behavior information report **109** to a third party service provider, signal source **80** (Fig.3; paragraph [0048]).

With respect to Claim **18**, the claimed "*wherein the sharing uses the communication network*" is met by Goldman that teaches the method of Claim **9** and the sharing of viewer behavior information report **109** with signal source **80** via the communication network **110** (Fig.3; paragraph [0048]).

Claim **19** is met as previously discussed with respect to Claim **1**. In addition, Goldman teaches a 1st location, home entertainment system **90**, which may consist of a addressable set top box {storage device **96**, processor **94**} & a television {display device **92**} using an EPG for the selection of video data, and the transmittal of information related to media selected for media consumption {viewer behavior information **98**- which may contain subscriber ID, channel ID, program ID and title, etc.}, via the internet, to server software {clearinghouse system **100**} which stores sent info {storage device **96**} (Figs.1-3; paragraphs [0027], [0033-0035], [0040-0042], & [0043]). The Examiner furthermore notes that the use of IP addresses is necessary to selectively address and direct data among set-top boxes exchanging data on an Internet network.

Furthermore, with respect to the claimed "*the server software sending notification of a media request to a second location based on a determination as to whether a set of predefined characteristics associated with the requested media matches at least on*

parameter related to monitoring media consumption activity at the first location” is met by Goldman that teaches the transmittal of compiled viewer behavior reports to numerous 2nd locations, home entertainment systems 90a-d, based upon whether or not select viewer behavior information **98**, from home entertainment systems matches those requested by the clearinghouse system **100** (*Figs.2, 3; paragraphs [0037], [0043],[0045]*).

Claim **20** is met as previously discussed with respect to Claim **5**.

Claim **21** is met as previously discussed with respect to Claim **6**.

Claim **22** is met as previously discussed with respect to Claim **2**.

Claim **23** is met as previously discussed with respect to Claim **3**.

Claim **24** is met as previously discussed with respect to Claim **1**.

Claim **25** is met as previously discussed with respect to Claim **7**.

With respect to Claim **26**, the claimed “server software that shares, with a third party, information derived from the received data” is met by Goldman that teaches the system of Claim **19**, and the transmittal of a viewer behavior information report **109**, by clearinghouse system **100**, to a third party service provider, signal source **80** (*Fig.3; paragraph [0048]*).

Claim **27** is met as previously discussed with respect to Claim **8**.

Claim **28** is met as previously discussed with respect to Claim **1**. Furthermore, Goldman teaches a 1st location, home entertainment system **90**, which may consist of addressable set top box circuitry{storage device **96**, processor **94**, mass storage device **50**} & a television {display device **92**, **14**} using an EPG for the selection of video data,

and the transmittal of information related to media selected for media consumption {viewer behavior information **98**- which may contain subscriber ID, channel ID, program ID and title, etc.}, via the internet, to server software {clearinghouse system **100**} which stores sent info {storage device **104**} (Figs. 1-3, 6; paragraphs [0027], [0033-0035], [0040-0043], [0060], [0061], & [0065]). The Examiner furthermore notes that the use of IP addresses is necessary to selectively address and direct data among set-top boxes exchanging data on an Internet network.

Furthermore, with respect to the claimed *"the software sending notification of a media request to a second location based on a determination as to whether a set of predefined characteristics associated with the requested media matches at least on parameter related to monitoring media consumption activity at the first location"* is met by Goldman that teaches the transmittal of compiled viewer behavior reports to numerous 2nd locations, home entertainment systems 90a-d, based upon whether or not select viewer behavior information **98**, from home entertainment systems matches those requested by the clearinghouse system **100** (Figs. 2, 3; paragraphs [0037], [0043], [0045]).

Claim **29** is met as previously discussed with respect to Claim **5**.

Claim **30** is met as previously discussed with respect to Claim **6**.

Claim **31** is met as previously discussed with respect to Claim **2**.

Claim **32** is met as previously discussed with respect to Claim **3**.

Claim **33** is met as previously discussed with respect to Claim **1**.

Claim **34** is met as previously discussed with respect to Claim **7**.

With respect to Claim **35**, the claimed "*wherein the software shares, with a third party, information derived from the received data*" is met by Goldman teaching the use of a storage device **104** for the gathering of viewer behavior information **98** at the clearinghouse system **100**, the creation of a viewer behavior information report **109**, and the transmittal of **109** to a third party, signal source **80** (*Fig. 3; paragraphs [0043] & [0048]*).

Claim **36** is met as previously discussed with respect to Claim **8**.

With respect to Claim **37**, the claimed "*wherein the software comprises server software*" is met by Goldman teaching the use of a clearinghouse system **100** in the compilation/creation a viewer behavior information report (*Fig.3; paragraphs [0043]-[0045]*).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jorge Mendoza Jr.** whose telephone number is (571) 270-5087. The examiner can normally be reached on Monday through Thursday 9:00 am –7:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Scott Beliveau** can be reached at (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

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applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JORGE MENDOZA JR/

Examiner, Art Unit 2623

/Scott Beliveau/

Supervisory Patent Examiner, Art Unit 2623